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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,522	06/14/1999	MICHAEL R. COSTA	7326-101	3045

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JAN P. BRUNELLE
EXELIXIS, INC.
170 HARBOR WAY
P.O. BOX 511
SOUTH SAN FRANCISCO, CA 94083-0511

EXAMINER

SHUKLA, RAM R

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 02/14/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/332,522

Applicant(s)

COSTA ET AL.

Examiner

Ram R Shukla

Art Unit

1632

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-4, 6, 8-11, 13-18, 22, 23, 25-28 and 34-36.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



Continuation of 2. NOTE: It is noted that the proposed amendments to claims 1 and 34-36 recite particular SEQ ID NO which were not claimed previously and in fact the sequence contained in these sequences were not present in the specification before the proposed amendment. It is noted that while the sequences were incorporated in the specification by reference, for their considerations in the amended claims as proposed, a new sequence search would be required. Accordingly, these SEQ ID NOs raise new issues which would require new search and further consideration. Regarding the sequence listing and the amendment to the specification, it is noted that they are not entered since amendments can not be entered in part. Furthermore, proposed amendments to claims 13 and 22 also raise new issues. In case of claim 13, proposed amendment recite the term identifying a gene whereas the claim as examined in the previous office action was drawn to studying lipid metabolism. A method of identifying a gene is different from a method of studying metabolism and therefore a new search and consideration would be required. In case of claim 22, the proposed amendment changes the conditions of hybridization and of washing. Again these conditions were not considered in the previous office action and nucleic acids isolated under the proposed conditions would be different from those isolated by the conditions previously considered and therefore a new search and consideration would be required.

Continuation of 5. does NOT place the application in condition for allowance because: Applicants arguments have been considered, however they are not persuasive to overcome the rejections set forth in the previous office action of 7-3-01. Regarding the new matter rejection of the term "genetically engineered" applicants' arguments are persuasive, however, regarding the term "intestinal defect phenotype", applicants arguments are not persuasive. It is noted that intestinal defect phenotype is not an art recognized term and that the specification does not define as to what phenotypes would be encompassed by this term. Furthermore, none of the sections of the specification or claims as quoted by the applicants in their response describes the term or uses the term. Applicants citation of the MPEP 2163.07 is in appropriate because the issue at hand is not a rephrasing of a passage, rather it is a new term that is not defined or disclosed in the specification. Regarding the enablement issues and description issues, it is noted that applicants' arguments are directed to claims after proposed amendments would be entered and in view of the non-entry of the proposed amendments these arguments would not be addressed.

DAVE T. NGUYEN
PRIMARY EXAMINER